

Application No.: 10/005,862

Docket No.: 20136-00328-US

REMARKS

Withdrawal of the rejection of claims 1-16 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is requested. Claims 1-16 are statutory, and meet the requirements of M.P.E.P. 2106.

M.P.E.P. 2106 identifies processes which are limited to a practical application, such as a claimed computer process, as statutory subject matter.

A claim that is limited to a practical application when the method as claimed produces a concrete, tangible and useful result *i.e.*, the method recites a step or active producing something that is concrete tangible and useful is statutory subject matter. Independent claim 1 has been amended to indicate that it is a computerized process which produces a concrete, tangible and useful result and is therefore, statutory subject matter (see *State Street Bank and Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1374, 47 USPQ2d 1596, 1601-1602 (Fed. Cir. 1998)) and the Commissioners Examination Guidelines for Computer Related Inventions ("Guidelines").

The present invention is directed to collecting data indicating the amount of usage of each component in an information technology system, reporting the data and correlating the usage date with various services for which the component is used to obtain the value of a component in an IT system. System claims 10-16 are directed to apparatus to manage an IT infrastructure system. Each apparatus has an agent to identify which of the components of the system is used to provide a service performed by the IT infrastructure. An information collection system collects from the various agents transaction information to determine which of the components are involved in the transaction. From the collected data, it is possible to determine a value of the component being used in the service. Each of the elements of the rejected apparatus claims are in themselves apparatus which, when combined, provide a system for managing an IT infrastructure. The claimed elements cannot be considered "mere ideas in the abstract." The elements used to manage large information technology systems are far beyond the characterization of an "abstract idea."

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Withdrawal of the rejection of the claims under 35 U.S.C. § 112 is requested.

Claim 2 has been amended to make it clear that the component value is determined from usage statistics accumulated at each component.

The objection to claim 1 is traversed. The allegation in the Office Action, that, it is unclear what the Applicant regards as his invention because these limitations fail to identify what is occurring the process, is not a sufficient basis on which to reject the claim under 35 U.S.C. § 112. The purpose of the claims under 35 U.S.C. § 112 is to:

set forth the subject matter that Applicant regards as their invention; and the claims must particularly point out and distinctly define the meets and bounds of the subject matter that will be protected by the patent grant. M.P.E.P. 2171.

The objections raised to the Examiner, that it is unclear as to what is distinctly occurring by the Applicants invention, goes to requirements of 35 U.S.C. § 112, paragraph 1. This paragraph requires a written description and enablement of the invention which addresses such concerns. The inquiry "as to how and when an evaluation function is constructed, what evaluation function is specifically used, and how values for components and a value for an IT system is determined based on correlations" is set forth in the specification, and it is not necessary to define such details in the claims themselves.

As to claim 10, objection is made to the terminology "said system determined from said transaction information." In reviewing the claims, the claims have always recited the terminology --said system determining from--. Accordingly, the suggested amendment to the claim contained in the Office Action is in fact part of the claim as it stands.

Claim 14 has been amended as suggested in the Office Action.

Claim 16 has also been amended as proposed.

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Withdrawal of the rejection of claims 1-16 under 35 U.S.C. § 102(a) and (e) as being anticipated by Andriaans et al. (U.S. Pat. No. 6,311,175) is requested. The rejected claims are directed to a process for managing an integrated information technology IT system. As part of the management process, the value of each component is determined based on transaction information derived from the component. When the component is involved in providing a service of the IT system, the usage data is reported for each service. The service has a value to the system owner. The service and components are correlated, so that it can be determined how much value the component has to the system based on the value of the service.

In reviewing the cited reference, a system is disclosed to measure the performance of an information technology system. The system is directed to determining how each component is performing electrically so that the system performance from a technical basis may be evaluated.

The system disclosed in the reference automatically creates models of the system, and, based on the performance of the models, can effect management of the system. The dynamic learning model is derived by determining various thresholds for system performance which are referred to as service level agreements (SLA's). These are numerical values which represent some particular physical performance threshold of a system component. In the example in the patent, the access time to servers is one such SLA. These values of component performance are determined from a test program or simulation and collected in a data base. The data collected in response to the test data is used to update an IT model of the system. In this way, the performance of the system can be modeled.

The present invention determines the value (as distinguished from physical performance) of components in an IT system for every service being offered is not disclosed in the reference. All of the measurements made in the the reference relate to hardware component physical performance during various test scenarios. The present invention is distinctly different in that it is used to determine a value of component by collecting actual usage data from the components, and deriving for each service provided by the system a value for the component.

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As it can be seen, the elements of process claim 1, including collecting usage data indicating the amount of usage a component receives in providing a service of a plurality of services, reporting the usage data for each service and correlating the service of each component so that the value of the component can be derived, based on the value on the service performed, is not disclosed or suggested in the reference.

The subject matter of each of claims 2-9 is also not disclosed in the reference. For instance, there is no component value determined for claim 2 based on usage statistics. Further, the step of evaluating the worth of each component per claim 3, or constructing a relationship table identifying the components used in providing each service per claim 4, is not shown in the reference.

In order to anticipate a claim, the reference must show each and every element of the claim M.P.E.P § 2131 (see the Brief on Appeal filed in the previous appeal in this case). The rejection under 35 U.S.C. § 102 is, therefore, not sustainable.

In view of the foregoing, where it has been demonstrated that the claims are patentable, favorable reconsideration is believed to be in order.

It is noted that this application has had an extensive prosecution, including an Appeal to the Board of Patent Appeals and Interferences. It is requested that the Examiner consider calling the undersigned, if any further cooperation will expedite prosecution of the application.

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Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 09-0458, under Order No. 20136-00328-US from which the undersigned is authorized to draw.

Dated:

9/7/04

Respectfully submitted,

By



George R. Pettit, Reg. No. 27,369

CONNOLLY BOVE LODGE & HUTZ LLP

1990 M Street, N.W., Suite 800

Washington, DC 20036-3425

(202) 331-7111

(202) 293-6229 (Fax)

Attorney for Applicant